

**TRANSMITTAL OF REPLY BRIEF**Docket No.
0020-4864P

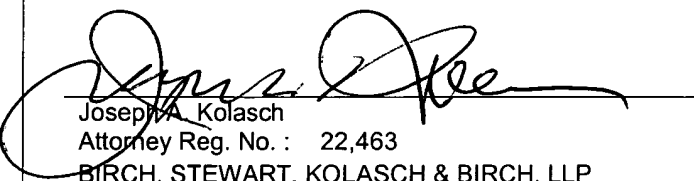
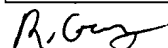
In re Application of: Kazuhisa FUSHIHARA

Application No.
09/854,693-Conf. #8117Filing Date
May 15, 2001Examiner
R. GordonGroup Art Unit
3711

Invention: FLOATABLE GOLF BALL FOR DRIVING RANGE

TO THE COMMISSIONER OF PATENTS:Transmitted herewith is the Reply Brief in this application, with respect to the Examiner's Answer mailed: June 1, 2005The fee for filing this Reply Brief is \$0.00 .☒ Large Entity ☐ Small Entity☐ A petition for extension of time is also enclosed.

The fee for the extension of time is _____ .

☐ A check in the amount of _____ is enclosed.☐ Charge the amount of the fee to Deposit Account No. _____ .
This sheet is submitted in duplicate.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 02-2448 .
This sheet is submitted in duplicate.
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PATENT
0020-4864P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In Re Application of

Before the Board of Appeals

Kazuhisa Fushihara

Appeal No.

Appl. No.: 09/854,693

Group: 3711

Filed: May 15, 2001

Examiner: R. Gordon

Conf. No.: 8117

For: FLOATABLE GOLF BALL FOR DRIVING RANGE

REPLY BRIEF UNDER 37 C.F.R. 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 29, 2005

Sir:

This Reply Brief is respectfully submitted on behalf of Appellants in response to the newly submitted arguments of the Examiner in the Examiner's Answer mailed June 1, 2005, which issued in connection with the above-identified application. In accordance with 37 C.F.R. §41.41, these new points of argument are responded to in the instant Reply Brief.

Status of Rejection

Claim 1 is rejected under 35 U.S.C. 103(a) as being obvious over Yoshimasa et al. (JP 06-327791).

New Points of Argument in the Examiner's Answer

At pages 2 to 6 of the Examiner's Answer, the Examiner maintains the rejection under 35 U.S.C. 103(a) over Yoshimasa et al. (JP 06-327791).

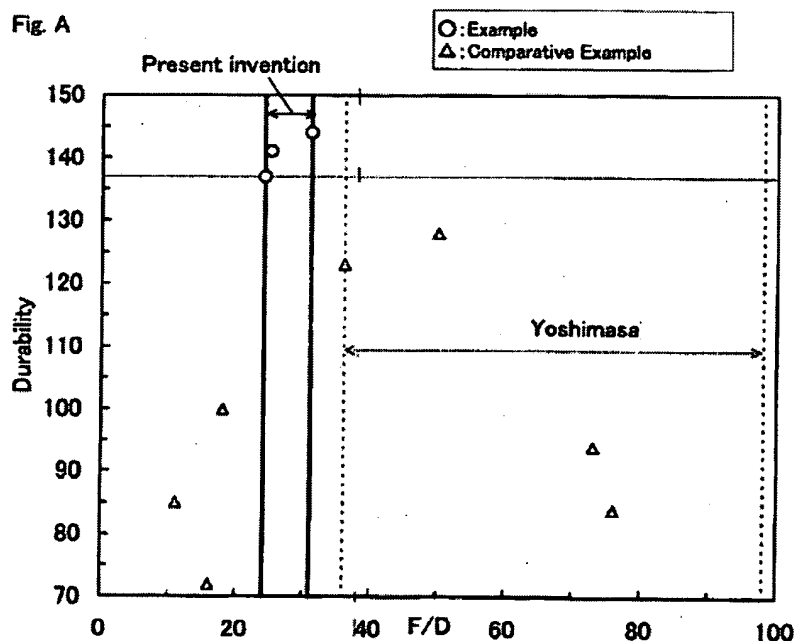
At page 5 of the Examiner's Answer, the Examiner notes that claim 1 sets forth that the ratio (F/D) of the flexural modulus of the cover (F) to the deformation amount of the golf ball (D) is within the range of 24 to 31. The Examiner asserts that no showing of criticality has been made because the specification discusses the critical range as being from 15 to 50. Also, the Examiner asserts that the Appellant is being contradictory in the Analysis of the data in the specification as is graphically presented in Figures A and B.

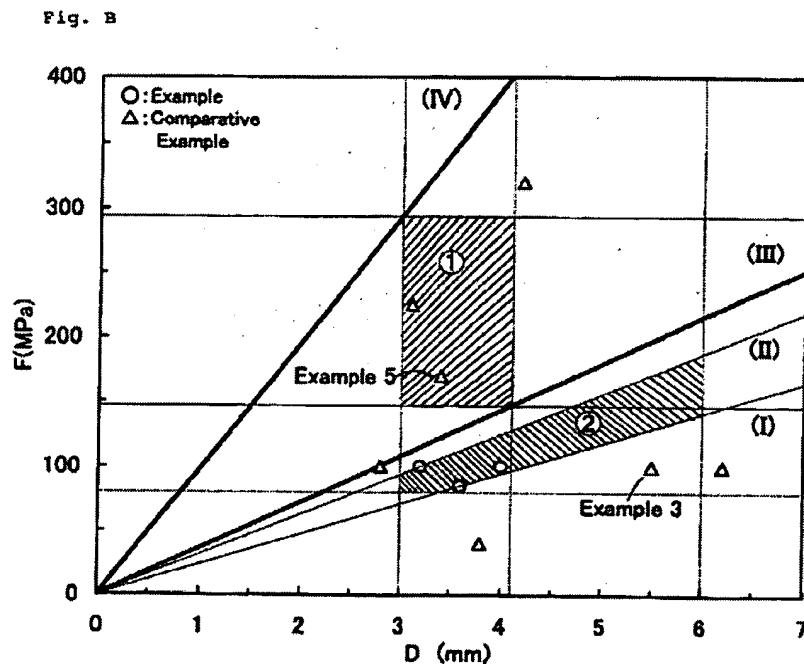
However, paragraph 0013 of the specification discloses that the upper limit of the ratio (F/D) is 50, preferably 40, more preferably 35, most preferably 31, and a lower limit of the ratio (F/D) is 15, preferably 19 and most preferably 24.

The Appellant has amended claim 1 from the (F/D) ratio of 15-50 to the (F/D) ratio of 24-31 by selecting the more preferable lower limit (24) and the most preferable upper limit (31). The golf balls of the present invention having

the (F/D) ratio of 15-50 (for example, the golf balls of Examples 1-5 of the specification) have superior performance compared to conventional golf balls (for example, Comparative Examples 1-5 in the specification).

Additionally, the golf balls having the (F/D) ratio of 24-31 have better performance, such as durability, among the golf balls of the present invention. The Appellant has explained the (F/D) ratios described above by using Figures A and B based on the values in Tables 5 and 6 of the original specification. That is, Figures A and B graphically represent the values of Tables 5 and 6 of the specification.





At page 5 of the Examiner's Answer, the Examiner further asserts that the Appellant is utilizing Examples 3 and 5 of the original specification as Comparative Examples in the Appeal Brief. However, an Appellant has wide latitude in defining his invention over the prior art.

That what appellants claim as patentable to them is less than what they describe as theirs in the specification is less than what they describe as their invention is not conclusive if their specification reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). See also In re Brower, 433 F.2d 813, 167 USPQ 684 (CCPA 1970)(Claims in a continuation application were directed to subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefit of the parent application's filing date).

Also, at page 6 of the Advisory Action, the Examiner turns to the Appellant's own specification at page 25 to assert that the specification contradicts the criticality of the claimed F/D ratio. However, the Examiner is in effect utilizing the Appellant's own disclosure as prior art. Absent an admission of prior art, an Appellant's own disclosure cannot be utilized as prior art. "The court must be ever alert not to read obviousness into an invention on the basis of the Applicant's own statements, that is, we must view the prior art without reading into that art appellant's teachings." In re Nomiya, 509 F.2d 566, 184 USPQ 607, 612 (CCPA 1975). See also Riverwood International Corp. v. R.A. Jones & Co., Inc., 324 F.3d 1346, 66 U.S.P.Q.2d 1331 (Fed. Cir. 2003) ("One's own work may not be considered prior art in the absence of a statutory basis, and a patentee should not be 'punished' for being as inclusive as possible . . .").

Additionally, utilizing the Appellant's own disclosure to show a lack of criticality also infers that the Examiner is using impermissible hindsight reconstruction to essentially posit an obviousness rejection based upon Yoshimasa et al. combined with the Appellant's own disclosure.

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (CAFC 1999). See also In re Kotzab, 217 F.3d 1365, 1369-70, 55

USPQ2d 1313, 1316 (CAFC 2000). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Dembiczak at 50 USPQ2d 1617. "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Dembiczak at 50 USPQ2d 1617.

The patent examination process centers on prior art and the examination thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references riled on as evidence of obviousness . . . The factual inquiry must be thorough and searching. It must be based on objective evidence of record. In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-44 (Fed. Cir. 2002).

Further, both the inability to establish *prima facie* obviousness and the unexpected results (graphically shown in Figures A and B) should establish patentability of the claimed invention.

The determination of obviousness, *vel non*, requires that all the evidence be considered together . . . if rebuttal evidence of adequate weight is produced, a holding of *prima facie* obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. The objective evidence of unobviousness is not evaluated for its 'separate knockdown ability' against the 'stonewall' of the *prima facie* case . . . but is considered together with all other evidence, in determining whether the invention is as a whole would have been obvious to a person of ordinary skill in the field of the invention. (citations omitted). Applied Materials Inc. v. Advanced Semiconductor Materials, 98 F.3d 1563, 1569 40 USPQ2d 1481, 1485 (Fed. Cir. 1996).

As a result, the Examiner erred when refusing to give the data set forth in the specification patentable weight over Yoshimasa et al.

Conclusion

Based on the above considerations, the Appellant accordingly continues to maintain that the Examiner's prior art rejection over Yoshimasa et al. as set forth in the final Office Action remains improper, both in fact and in law. The Examiner further has not established a *prima facie* case of obviousness and fails to take into account Appellant's rebuttal evidence. The Examiner's new points of arguments have not changed this position. The Appellant therefore respectfully requests the Board of Appeals reverse the Examiner's final rejections of the appealed claims and render a decision favorable to the Appellants.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

Date: July 29, 2005


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